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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,920	10/24/2003	Gail Hegarty Fell	PANAMSAT-CONTINUATION	5346

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EXAMINER
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EWART, JAMES D

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,920	<b>Applicant(s)</b> FELL ET AL.	
	<b>Examiner</b> James D. Ewart	<b>Art Unit</b> 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006 amendment.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 May 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

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### ***Response to Arguments***

1. Applicant's arguments filed May 30, 2006, have been fully considered by Examiner, but are deemed moot in view of new grounds of rejection.
2. Regarding the addition of the limitation of using a controller for delivery and pickup of the files, since the claims of Patent 6,674,994 include the schedule with the pickup and delivery information, it would be obvious to use a controller for the pickup and delivery of the files according to the scheduling order and the Examiner maintains the double patenting rejection.
3. The Examiner has signed and dated the amended IDS.
4. The amendment to the specification has overcome the Examiner's objection regarding the continuation application number.
5. Amended claims 2,10,19 and 23 have overcome the Examiner's format objections.
6. Amendment to claims 13 & 14 has overcome the 35 USC § 112 rejections.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application

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claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-13 and 15-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-7 of U.S. Patent No. 6,674,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application removed a limitation, which made the parent application allowable and added a screen-based interface, which is common with most servers and added a controller, which is a common device for handling data instructions.

### ***Drawings***

8. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 – 13 and 15-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrity et al. (U.S. Patent No. 6,745,237).

Referring to claim 1, Garrity et al. discloses a method for file transfer (Figure 1), comprising: retrieving a file by a controller (Figure 1, 136) from a sender location (Figure 1, 102,104,106) in accordance with a scheduling order created by a sender (Column 15, Lines 23-28) using a screen-based interface (Column 8, Lines 56-64); and transmitting a file using a satellite communications link in accordance with the scheduling order (Figure 1, 144; Column 3, Line 66 to Column 4, Lines 2 and Column 4, Lines 49-51).

Referring to claim 9, Garrity et al. discloses a system for file transfer (Figure 1), comprising: a transmitter for transmitting a file from a sender (Figure 1, 102,104,106) using a satellite communications link (Figure 1, 144) in accordance with a scheduling order created by the sender (Column 15, Lines 23-28) using a screen-based interface (Column 8, Lines 56-64) specifying instructions on file pickup from a sender location and file delivery (Column 15, Lines 23-28) and a controller, coupled to the transmitter and the sender, for retrieving and delivering the file in accordance with the scheduling order (Figure 1, 136).

Referring to claim 17, Garrity et al. teaches a user interface for scheduling a file transfer, via a satellite communication system (Figure 1) comprising: a terminal for displaying a data

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screen to a sender (Column 8, Lines 56-64), the data screen including pickup and delivery of the content (Column 15, lines 23-28) and two or more of the following fields specifying a file location, size (Figure 6, 626 bandwidth requirements and Column 9, Line 29), pickup time, payment type (Figure 6, 626 billing and Column 9, Line 30), confirmation type and delivery time, and means for sending information displayed on the data screen to a controller for picking up and delivering the file being transferred (Column 15, Lines 23-28).

Referring to claims 18 and 22, Garrity et al. discloses a method and system for file reception (Figure 1), comprising: receiving a file that has been transmitted using a satellite communications link (Figure 1, 144) in accordance with a scheduling order (Column 15, Lines 23-28), wherein the scheduling order is created by a sender using a screen-based interface (Column 8, Lines 56-64) and comprises instructions to a controller for file pickup from a sender location and file delivery (Column 15, Lines 23-28).

Referring to claims 2, 10, 19 and 23, Garrity et al. further teaches, confirming to a provider that the file has been transmitted/received (Column 14, Lines 18-26 and Column 13, Lines 45-49).

Referring to claims 3 and 11, Garrity et al. further teaches wherein the transmitting is simultaneously performed to selected destinations that are part of a predefined group / subscribers excluding some destinations in a geographic area (Column 1, Lines 40-41 and

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Column 3, Lines 39-41). Geographic area includes the entire coverage area and those not belonging to the multicast group are excluded.

Referring to claims 4 and 12, Garrity et al. further discloses receiving the scheduling order from a user, the scheduling order also specifying at least one location (Column 6, Lines 58-60) and time for retrieval of the file (Column 5, Lines 4-6 and Column 6, lines 50-54). The claim does not indicate the location and time is input by the user.

Referring to claims 5 and 13, Garrity et al. further teaches checking facility availability in response to receiving the scheduling order (Column 2, Lines 18 – 26 and Column 6, Lines 5-53)).

Referring to claim 6, Garrity et al. further teaches sending a confirmation notice to the user after checking facility availability (Column 9, Lines 64-66 and Figure 6, 636).

Referring to claim 7 and 15, Garrity et al. further teaches converting the format of the file (Column 8, Lines 20-23, Column 13, Line 37 and Figure 6, 626 encryption)

Referring to claim 8 and 16, Garrity et al. further teaches storing / buffering the file for a predetermined amount of time (Figure 11).

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Referring to claims 20 and 24, Garrity et al. further discloses wherein the file has been transmitted by multicasting (Column 1, Lines 40-41 and Column 3, Lines 39-41).

Referring to claims 21 and 25, Garrity et al. further teaches confirming availability of delivery according to the scheduling order, and wherein the confirming of availability occurs before the receiving of the file (Column 4, Lines 64-67).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brewster et al. U.S. Patent No. 7,065,497 discloses document delivery system for automatically printing a document on a printing device.

Dasan U.S. Patent No. 5,761,662 discloses personalized information retrieval using user-defined profile.

Ferguson U.S. Patent No. 5,649,186 discloses system and method for a computer based dynamic information clipping service.

Payton U.S. Patent No. 5,790,935 discloses virtual on-demand digital information delivery system and method.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.

  
Ewart  
June 22, 2006

  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER